

### **REMARKS**

This Amendment is responsive to the Office Action mailed October 10, 2006. With this Amendment, claims 1-3, 6-8, 10, 13-15, 18-26 have been amended, new claim 47 has been added and claim 27 has been cancelled, without prejudice. Support for the amended and new claims is found in the originally filed application. Accordingly, no new matter has been added.

#### **35 U.S.C. §112 Rejections**

Claim 2 stands rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. In particular, the Examiner indicates that the recitation of “out” in line 2 has insufficient antecedent basis.

Applicant has amended claim 2 to delete “out” and replace it with “outlet” to cure a typographical error. Applicant respectfully requests that the rejection of claim 2 under 35 U.S.C. §112, second paragraph, be withdrawn.

#### **35 U.S.C. §102 Rejections**

Under the heading “Claim Rejections – 35 USC § 102” the Office Action does not set forth any 35 U.S.C. §102 rejections. However, under the heading “Claim Rejections – 35 USC § 103”, the Examiner sets forth that claims 1 and 2 stand rejected under 35 U.S.C. §102(b) as being anticipated by Panescu et al., U.S. Patent No. 6,056,745.

As acknowledged by the Office Action at page 3, Panescu et al. does not teach the portion of the electrode tip extending distally beyond the distal end of the shaft comprising a cone shaped portion as recited by claim 1. At least for this reason, Panescu et al. does not anticipate claims 1 and 2, and the rejection of claims 1 and 2 under 35 U.S.C. §102(b) as being anticipated by Panescu et al. is believed to be erroneous.

### **35 U.S.C. §103 Rejections**

Claims 1-46 [sic] stand rejected under 35 U.S.C. §103(a) as being unpatentable over Panescu et al., U.S. Patent No. 6,056,745. Applicant respectfully disagrees with the rejection. In interpreting Panescu et al., the Examiner provides the following in the Office Action:

Panescu et al. disclose an electrosurgical device have a proximal end and a distal end, the device comprising: a handle; a shaft extending from the handle, the shaft having a distal end; a fluid passage being connectable to a fluid source; an electrode tip having an electrode surface, at least a portion of the electrode tip extending distally beyond the distal end of the shaft; and at least one fluid outlet opening in fluid communication with the fluid passage and the at least one fluid outlet opening is arranged to provide a fluid from the fluid source to the electrode tip.

Panescu et al. teach all of the limitations of the claims except the portion of the electrode tip extending distally beyond the distal end of the shaft comprising a cone shaped portion and at least a portion of the electrode surface has a contact angle with a fluid from the fluid source of less than 90 degrees. To have provided a cone shaped electrode would have been an obvious modification to one of ordinary skill in the art at the time the invention was made, since it has been held to be within the general skill of a worker in the art to select a shape on the basis of its suitability for the intended use as a matter of obvious design choice.

Undeniably, it is well known by the Examiner that the initial burden of establishing a basis for denying patentability to a claimed invention rests upon the Examiner. See *In re Piasecki*, 745 F.2d 1468, 1471-1473, 223 USPQ 785, 787-788 (Fed. Cir 1984). To reject claims in an application under section 103, an examiner must show an un rebutted *prima facie* case of obviousness. See *In re Deuel*, 51 F.3d 1552, 1557, 34 USPQ2d 1210, 1214 (Fed. Cir. 1995). In the absence of a proper *prima facie* case of obviousness, an applicant who complies with the other statutory requirements is entitled to a patent. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2D 1443, 1444 (Fed. Cir. 1992).

There are no *per se* rules when determining obviousness under 35 U.S.C. § 103. See *In re Ochiai*, 71 F.3d 1565, 1572, 37 USPQ2d 1127, 1133 (Fed. Cir. 1995) (“The use of *per se* rules, while undoubtedly less laborious than a searching comparison of the claimed invention-including all its limitations-with the teachings of the prior art, flouts section 103 and the fundamental case law applying it. *Per se* rules that eliminate the need for fact-specific analysis of claims and prior art may be administratively convenient for PTO examiners and the Board. Indeed, they have been sanctioned by the Board as well. But reliance on *per se* rules of

obviousness is legally incorrect...”). Thus, the Examiner has yet to set forth a legally valid rejection of the claims. In light of the Examiner’s failure to make a prima facie case of obviousness, the Applicant is under no obligation to submit evidence of nonobviousness. See *Manual of Patent Examining Procedure*, 8<sup>th</sup> Ed., Rev. 5, § 2142.

Even if the Examiner’s rejection of the claims could somehow be construed as legally valid, Applicant respectfully disagrees with the Examiner’s rejection of the claims as being unpatentable over Panescu et al. for other reasons.

Panescu et al. is directed to a steerable catheter 14. (Col. 4, line 24-25) The catheter 14 includes a flexible catheter body 22. (Col. 4, line 52) The flexibility is required to make the catheter steerable through a main vein or artery, into the heart, where the electrode is then placed in contact with the tissue within the heart that is targeted for ablation. (Col. 4, lines 41-46)

One concern of surgeons during advancement of catheters through blood vessels is the risk of perforation to the vessels. Perforation is often thought to occur as a result of trauma on the blood vessel resulting from the catheter tip.

Turning to Applicant’s claimed invention, it comprises, among other things, an electrode tip having a cone shaped portion. In light of the risk of perforation to the vessel by an electrode tip having such a shape, one of ordinary skill in the art would be led away from advancing Applicant’s invention into and through a vessel up against heart, as is done with the device of Panescu et al., for fear of tearing and/or puncturing the vessel wall and/or the heart wall. Consequently, rather than demonstrating that Applicant’s invention is obvious, Panescu et al. demonstrates quite well that Applicant’s invention is not obvious.

Notwithstanding the foregoing deficiencies of the rejection against the claims, Applicant has elected to amend independent claims 1, 18, 21, 23 and 25 to expedite prosecution and further distinguish from the art, thus rendering any further discussion of the rejection against the claims moot. In particular, Applicant has amended claims 1, 18, 21, 23 and 25 to recite a shaft supporting an electrode tip in rigid relation to the handle. Support may be found, for example, at page 23, lines 19-21.

Panescu et al. does not teach or suggest a shaft supporting an electrode tip in rigid relation to the handle as recited in amended independent claims 1, 18, 21, 23 and 25. As indicated in the MPEP, if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to

make the proposed modification. See MPEP 2143.02, *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Panescu et al. makes use of a flexible catheter body 22 (col. 4, line 52). The flexibility is required to make the catheter steerable through a main vein or artery (col. 4, lines 41-44). Thus, for Panescu et al. to have such a shaft as recited in amended claims 1, 18, 21, 23 and 25 is not possible, given the need for Panescu et al.'s catheter body to advance through a patient's blood vessels.

In view of the foregoing amendments and remarks, it is respectfully submitted that amended independent claims 1, 18, 21, 23 and 25, as well as the claims which depend directly or ultimately therefrom (i.e. claims 2-17, 19-20, 22, 24, 26 and 40-46) are not unpatentable over Panescu et al., the conditions of patentability have been satisfied and that the rejection of claims should be withdrawn upon reconsideration.

In addition to the foregoing amendments, the Applicant has amended certain claims to further distinguish from the art, as well as address grammatical and antecedent basis matters.

#### **New Claims**

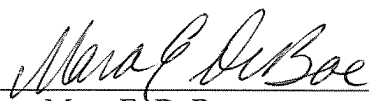
New independent claim 47 has been added. No claim fee is believed due. In the event there are any fee deficiencies or additional fees are payable, please charge them (or credit any overpayment) to our Deposit Account 13-2725.

#### **Summary**

In view of the above amendments and remarks, Applicant respectfully requests a Notice of Allowance. The Examiner is invited to telephone the undersigned at the below-listed number in order to facilitate advancement of the prosecution of this application.

Respectfully submitted,  
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By:   
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